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Docket H10125JDP
Customer No. 01333

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of

David R. Hansen

**METHODS FOR DIGITALLY
PRINTING COMPOSITE
DOCUMENTS**

Serial No. 09/729,302

Filed 04 December 2000

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Group Art Unit: 2624

Examiner: James A. Thompson

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Debbie Nowacki
Debbie Nowacki

September 1, 2006
Date

Sir:

SUPPLEMENTAL APPEAL BRIEF TRANSMITTAL

In response to the Notification of Non-Compliant Appeal Brief dated August 11, 2006, please find enclosed herewith Appellants' Supplemental Appeal Brief for the above-identified application.

No fees are believed due for this transmittal as the original Appeal Brief filed on July 15, 2005 included an authorization to charge the Appeal Brief filing fee to Deposit Account no. 05-0225. If, however, fees are due for this transmittal, the Commissioner is hereby authorized to charge the Appeal Brief filing fee to Eastman Kodak Company Deposit Account 05-0225.

Respectfully submitted,

Justin D. Petruzzelli/d-n
Telephone: 585-726-7522
Facsimile: 585-477-4646

Enclosures

If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.

Justin D. Petruzzelli

Attorney for Appellants
Registration No. 52,118



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SUPPLEMENTAL APPEAL BRIEF PURSUANT TO 37 C.F.R. 41.37 (c) (1)

(ix) and (c) (1) (x)

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APPELLANT'S BRIEF ON APPEAL

Appellants hereby appeal to the Board of Patent Appeals and Interferences from the Examiner's Final Rejection of claims 40-63 which was contained in the Office Action mailed February 18, 2005.

A timely Notice of Appeal was filed on May 18, 2005.

Real Party In Interest

Eastman Kodak Company is the real party in interest.

Related Appeals And Interferences

No appeals or interferences are known which will directly affect or be directly affected by or have bearing on the Board's decision in the pending appeal.

Status Of The Claims

Claims 1-39 stand canceled from consideration pursuant to a response mailed May 26, 2004.

Claims 40-63 stand finally rejected and are the subject of this appeal.

Appendix I provides a clean, double spaced copy of the claims on appeal.

Status Of Amendments

No amendments were submitted after the final rejection.

Summary of Claimed Subject Matter

Independent claim 40 recites: A method of operating a print system to print an electronically formatted document having a plurality of pages comprising running a Print Document Management System (PDMS) program (page 10, line 18) on a computer 12 which receives the document into the Print Document Management System program; and displays in the PDMS a Graphical User Interface ("GUI") 14 which permits a print operator to assign group identifiers (page 12, line 19) into the document to establish groups of pages in the document (page 12, line 21) to thereby create an amended document and instruct

the computer to send one or more of the groups of pages of the amended document to an output data stream for printing (page 16, line 8).

Independent claim 52 recites: A system for printing a document having a plurality of pages formatted in page description language (PDL) comprising a Print Document Management System (PDMS) program (page 10, line 18) for running on a computer 12, the PDMS program having a Graphical User Interface ("GUI") 14 facilitating:

receiving the document into the Print Document Management System program;

permitting a print operator to assign 32 group identifiers (page 12, line 19) into the document to establish groups of pages in the document (page 12, line 21) to thereby create an amended document; and,

permitting the print operator to instruct the computer to send one or more of the groups of pages of the amended document to an output data stream for printing (page 16, line 8).

Issues For Review By The Board

The grounds of rejection for review are:

(1) the rejection of claims 40, 42-43, 46, 48-50, 52, 54-55, 58 and 60-62 as being obvious under 35 U.S.C. §103(a) over Motoyama (U.S. Patent No. 5,353,388) in view of Hanson (U.S. Patent No. 5,956,736).

(2) the rejection of claims 41, 44, 47, 53, 56 and 59 as being obvious under 35 U.S.C. §103(a) over Motoyama (U.S. Patent No. 5,353,388) in view of Hanson (U.S. Patent No. 5,956,736) and Rourke (U.S. Patent No. 5,995,721).

(3) the rejection of claim 45 and 57 as being obvious under 35 U.S.C. §103(a) over Motoyama (U.S. Patent No. 5,353,388) in view of Hanson (U.S. Patent No. 5,956,736) and well-known prior art.

(4) the rejection of claim 51 and 63 as being obvious under 35 U.S.C. §103(a) over Motoyama (U.S. Patent No. 5,353,388) in view of Hanson (U.S. Patent No. 5,956,736) and Kato (U.S. Patent No. 5,978,557).

Arguments

A. The rejection of claims 40, 42-43, 46, 48-50, 52, 54-55, 58 and 60-62 as being obvious under 35 U.S.C. §103(a) over Motoyama (U.S. Patent No. 5,353,388) in view of Hanson (U.S. Patent No. 5,956,736).

Claims 40, 42-43, 46, 48-50, 52, 54-55, 58 and 60-62 are patentable over Motoyama in view of Hanson because there is no reason, suggestion, or motivation to combine the references in the manner required to produce the claimed invention.

In order to establish a prima facie case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. The teaching or suggestion to make the claimed combination must be found in the prior art and not based on applicant's disclosure. The mere fact that the prior art may be modified in the manner suggested does not make the modification obvious unless the prior art suggests the desirability of the modification. Motoyama and Hanson fail to suggest any motivation for, or desirability of, the changes espoused. Here, hindsight is relied upon to arrive at the determination of obviousness.

Motoyama teaches a document processing system that controls the printing of documents represented in page description language form. Documents are represented by a page description language which is structured so that definition and declaratory commands are positioned only at the beginning of each distinct document segment. Each document has prologue sections, which contain definition and declaratory commands, and content portions which contain the specific tokens or commands for defining specific images. The definition and declaratory commands in the prologue sections of the document are arranged in a hierarchical tree so that each definition and declaratory command has a scope corresponding to the portion of the hierarchical tree subtended by that command. A structure processor handles resource declaration and definitions, dictionary generation, context declarations and references to data external to the document. A content processor processes the tokens using the definitions and declarations set up by the structure processor, and an imaging driver module translates the document into commands suitable for any of several types of printers.

Motoyama **does not teach or suggest** a Graphical User Interface (“GUI”) which permits a print operator to assign group identifiers into a document to establish groups of pages in the document.

Hanson teaches an object-oriented HTML based editor for creating Web documents **to be published on the World Wide Web**. Each HTML command is treated as a unique object having associated properties. A user using an input device, such as a mouse, clicks and drags representations of objects representing HTML commands from a palette window on an output display device. The objects are dropped into a representation of a collection of objects in a view window on the output display device. Each one of the objects in the collection of objects may be edited by way of a context sensitive object editor window to customize the Web document. An object is selected by an input device and dragged to the object editor window, where the properties associated with the object are displayed and may be directly manipulated. Hanson **does not teach or suggest** having a plurality of pages comprising running a Print Document Management System on a computer which receives the document into the Print Document Management System program, permitting a print operator to assign group identifiers into the document to establish groups of pages in the document to thereby create an amended document and instructing the computer to send one or more of the groups of pages of the amended document to an output data stream for printing.

Applicants argue these references have been brought together through the use of an impermissible amount of hindsight and the teaching of the present invention, and not the references themselves. The references themselves teach the respective uses of their respective arrangements for their respective purposes, all of which are quite different from each other as between the two references. It is impermissible to first ascertain factually what applicant did and then view the prior art in such a manner as to select from the random facts of that art only those portions which are taken out of their elements and reconstructed to meet applicant’s method. It is not realistic when deciding obviousness to pick and choose from any one reference only so much as will support a given proposition and then add to another reference when there is no suggestion to do so. In *Smithkline Diagnostics Inc. v. Helena Laboratories Corp.*, 8 USPQ2d 1468 the

court stated it is impermissible to "...pick and choose among the individual elements of assorted prior art references to recreate the basis..." of applicant's invention. The court also stated "Not only must the claimed combination be considered as a whole under the express mandate of 35 U.S.C. §103, but the prior art references must also be considered in their entirety to determine whether they suggest the desirability of making the combination...". Applicant's claimed invention is novel as a whole, producing with its novel method a new type of product. Applicant's structure clearly defines over the reference when considering the prior art disclosures as a whole. Hindsight and Applicant's teachings must therefore now be used to reconstruct the present invention.

The Examiner argues "Motoyama and Hanson are combinable because they are from the same field of endeavor, namely digital document data processing". This argument, however, falls short of the necessary standard to create a prima facie obviousness suggestion, or motivation.

As the Applicant's have demonstrated, a combination of Motoyama and Hanson does not render claims 40 and 52 obvious because of the lack of motivation in these references to make the combination. Claims which further depend on this combination are therefore not obvious.

B. The rejection of claims 41, 44, 47, 53, 56 and 59 as being obvious under 35 U.S.C. §103(a) over Motoyama in view of Hanson and Rourke.

Claims 41, 44, 47, 53, 56 and 59 are patentable over Motoyama in view of Hanson and Rourke because there is no reason, suggestion, or motivation to combine the references in the manner required to produce the claimed invention.

In order to establish a prima facie case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. The teaching or suggestion to make the claimed combination must be found in the prior art and not based on applicant's disclosure. The mere fact that the prior art may be modified in the manner suggested does not make the modification obvious unless the prior art suggests the desirability of the modification. Motoyama, Hanson and Rourke fail

to suggest any motivation for, or desirability of, the changes espoused. Here, hindsight is relied upon to arrive at the determination of obviousness.

Applicants have argued above about the improper combination of Motoyama and Hanson.

Rourke teaches a document processing system including at least one document reproduction apparatus and managing on-demand output of a document job. The document job is characterized by a set of job attributes with each job attribute relating to a manner in which the document job is to be processed by the document processing system. The document processing system, which further includes a document server for managing conversion of the document job into the on-demand output, includes: a plurality of queues mapped to a plurality of document processing subsystems, each of the plurality of queues including a set of queue attributes characterizing the extent to which each document processing subsystem mapped to one or more of the plurality of queues is capable of processing a job portion delivered to the one or more queues. The document processing system further includes a queue utility communicating with the plurality of queues. The queue utility compares the set of job attributes and each set of queue attributes to generate a set of information corresponding the set of job attributes with those queues, among the plurality of queues, that are capable of completely processing at least a portion of the document job. Rourke **does not teach** a Print Document Management System which permits a print operator to assign group identifiers into a document to establish groups of pages in the document.

As the Applicant's have argued, it is not realistic when deciding obviousness to pick and choose from any one reference only so much as will support a given proposition and then add to another reference when there is no suggestion to do so.

(C) The rejection of claims 45 and 57 as being obvious under 35 U.S.C. §103(a) over Motoyama in view of Hanson and well-known prior art to enter text data into a dialog box.

Claims 45 and 57 are patentable over Motoyama in view of Hanson and well-known prior art because there is no reason, suggestion, or

motivation to combine the references in the manner required to produce the claimed invention.

In order to establish a prima facie case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. The teaching or suggestion to make the claimed combination must be found in the prior art and not based on applicant's disclosure. The mere fact that the prior art may be modified in the manner suggested does not make the modification obvious unless the prior art suggests the desirability of the modification. Motoyama, Hanson and well-known prior art fail to suggest any motivation for, or desirability of, the changes espoused. Here, hindsight is relied upon to arrive at the determination of obviousness.

Applicants have argued above about the improper combination of Motoyama and Hanson. As the Applicant's have argued, it is not realistic when deciding obviousness to pick and choose from any one reference only so much as will support a given proposition and then add to another reference when there is no suggestion to do so.

(D) The rejection of claims 51 and 63 as being obvious under 35 U.S.C. §103(a) over Motoyama in view of Hanson and Kato.

Claims 45 and 57 are patentable over Motoyama in view of Hanson and Kato because there is no reason, suggestion, or motivation to combine the references in the manner required to produce the claimed invention.

In order to establish a prima facie case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. The teaching or suggestion to make the claimed combination must be found in the prior art and not based on applicant's disclosure. The mere fact that the prior art may be modified in the manner suggested does not make the modification obvious unless the prior art suggests the desirability of the modification. Motoyama, Hanson and Kato fail to

suggest any motivation for, or desirability of, the changes espoused. Here, hindsight is relied upon to arrive at the determination of obviousness.

Applicants have argued above about the improper combination of Motoyama and Hanson.

Kato teaches printing dummy pages (replacement pages) with a predetermined message indicating insertion positions printed on a monochromatic or color printing side. Kato **does not teach** a Print Document Management System which permits a print operator to assign group identifiers into a document to establish groups of pages in the document.


As the Applicant's have argued, it is not realistic when deciding obviousness to pick and choose from any one reference only so much as will support a given proposition and then add to another reference when there is no suggestion to do so.

Conclusion

For the above reasons, Appellants respectfully request that the Board of Patent Appeals and Interferences reverse the rejection by the Examiner and mandate the allowance of Claims 40-63.

Respectfully submitted,

Justin D. Petruzzelli/d-n
Telephone: 585-726-7522
Facsimile: 585-477-4646
Enclosures



Attorney for Appellants
Registration No. 52,118

If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585)477-4656.

Appendix I - Claims on Appeal

40. A method of operating a print system to print an electronically formatted document having a plurality of pages comprising running a Print Document Management System (PDMS) program on a computer which receives the document into the Print Document Management System program; and displays in the PDMS a Graphical User Interface (“GUI”) which permits a print operator to assign group identifiers into the document to establish groups of pages in the document to thereby create an amended document and instruct the computer to send one or more of the groups of pages of the amended document to an output data stream for printing.

41. A method in accordance with claim 40, wherein the print operator instructs the computer to send multiple groups of pages simultaneously.

42. A method in accordance with claim 40, wherein the print operator instructs the computer to send some or all of the document to one or more printing devices.

43. A method in accordance with claim 40, wherein a printing device processes the amended document that it receives from the computer and prints one or more pages of the amended document.

44. A method in accordance with claim 40, wherein the print operator may select multiple groups of pages simultaneously for printing by inputting the identifiers for respective page groups to the computer.

45. A method in accordance with claim 40, wherein the PDMS receives the inputted identifiers through the GUI by prompting the printer operator to type the group identifiers into a dialog box.

46. A method in accordance with claim 40, wherein the PDMS receives the inputted identifiers through the GUI by prompting the printer operator to select group identifiers from a list of identifiers.

47. A method in accordance with claim 40, wherein the PDMS prompts the printer operator to associate each identifier with a printing device.

48. A method in accordance with claim 40, wherein the assignment of group identifiers is made by entering an address or other label that instructs the computer to format the groups for compatibility with input requirements of a printing device.

49. A method in accordance with claim 40, wherein at least one page of the document belongs to more than one group of pages.

50. A method in accordance with claim 40, wherein pages that do not have any identifiers define a null page group.

51. A method in accordance with claim 40, replacing pages not in the groups of pages sent into the output data stream with a media insertion command.

52. A system for printing a document having a plurality of pages formatted in page description language (PDL) comprising a Print Document Management System (PDMS) program for running on a computer, the PDMS program having a Graphical User Interface (“GUI”) facilitating:

receiving the document into the Print Document Management System program;

permitting a print operator to assign group identifiers into the document to establish groups of pages in the document to thereby create an amended document; and,

permitting the print operator to instruct the computer to send one or more of the groups of pages of the amended document to an output data stream for printing.

53. A system in accordance with claim 52, wherein the print operator instructs the computer to send multiple groups of pages simultaneously.

54. A system in accordance with claim 52, wherein the print operator instructs the computer to send some or all of the document to one or more printing devices.

55. A system in accordance with claim 52, wherein a printing device processes the amended document that it receives from the computer and prints one or more pages of the amended document.

56. A system in accordance with claim 52, wherein the print operator may select multiple groups of pages simultaneously for printing by inputting the identifiers for respective page groups to the computer.

57. A system in accordance with claim 52, wherein the PDMS receives the inputted identifiers through the GUI by prompting the printer operator to type the group identifiers into a dialog box.

58. A system in accordance with claim 52, wherein the PDMS receives the inputted identifiers through the GUI by prompting the printer operator to select group identifiers from a list of identifiers.

59. A system in accordance with claim 52, wherein the PDMS prompts the printer operator to associate each identifier with a printing device.

60. A system in accordance with claim 52, wherein the assignment of group identifiers is made by entering an address or other label that instructs the computer to format the groups for compatibility with input requirements of a printing device.

61. A system in accordance with claim 52, wherein at least one page of the document belongs to more than one group of pages.

62. A system in accordance with claim 52, wherein pages that do not have any identifiers define a null page group.

63. A system in accordance with claim 52, replacing pages that do not have any identifiers with a media insertion command.

Appendix II - Evidence

None

Appendix III – Related Proceedings

None